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REMARKS

Reconsideration of this application as amended is respectfully requested.

In the Office Action, claims 1-30 were pending and rejected. In this response, no claim has been canceled or amended. No new matter has been added.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,832,726 to Torchalski ("Torchalski"), in view of U.S. Patent No. 5,431,288 to Nishijima, et al., ("Nishijima"). Applicant hereby reserves the right to swear behind Torchalski.

It is respectfully submitted that claims 1-30 include limitations that are not disclosed by Torchalski and Nishijima, individually or in combination. Specifically, for example, independent claim 1 recites as follows:

1. A method, comprising:
capturing an original machine-readable code (MRC) at a location of a document;
generating a new MRC based on the original MRC, the new MRC representing the same data of the original MRC; and
replacing the original MRC with the new MRC, wherein the new MRC is located at substantially the same location as the original MRC with respect to the rest of the contents of the document.

(Emphasis added)

Independent claim 1 includes capturing an original MRC (e.g., a barcode) at a location of a document and generating a new MRC based on the captured original MRC, where the new MRC represents the same data of the original MRC, and automatically using the new MRC to replace the original MRC at substantially the same location as the original MRC on the document. It is respectfully submitted that the above limitations are absent from the cited references.

Rather, Torchalski is related to a software package that can scan an existing printed label into a memory where a user can generate a label format that can be used to print it out on a label subsequently (see Abstract and Summary, col. 3, lines 21 to 46 of Torchalski). However, Torchalski is not related to replacing an existing machine readable code located at a location of a document with a new machine readable code of the document. Rather, Torchalski is related to scanning an existing label and storing it as a template in a memory, where the scanned label can be printed from the memory subsequently.

In contrast, the present invention as claimed is related to scanning a document, locating and capturing an original MRC within the scanned document, generate a new MRC based on the captured original MRC, and replacing the original MRC with the new MRC at the same location of the document (e.g., same document). As a result, even if the original MRC were faded out in the ordinary usage, when the document containing the original MRC is scanned (e.g., copied), the original MRC is automatically located and captured to generate a new MRC. When the document is printed (e.g., via the copy machine), the new MRC is printed on the same location as the original MRC on the document, replacing the original MRC.

Nishijima is related to a mail sorting system that will convert a mailing address into a barcode and then print the barcode on a blank area of the envelope, such that the mail item can be sorted later by scanning the barcode. See, for example, Nishijima, Abstract; Fig. 1; col. 2, line 33 to col. 3, line 20. That is, Nishijima is not designed to replace an old machine readable code with a new machine readable code such as a barcode.

It is respectfully submitted that one with ordinary skill in the art would not consider a mailing address printed as letters or characters as machine readable codes. Specifically, Nishijima requires a character recognition section to recognize the mailing address and to

quantize the recognized characters (see, e.g., col. 3, lines 3-20 of Nishijima). Thus, a mailing address is not a machine readable code. Otherwise, such a conversion from a mailing address to a barcode would not be needed.

Even if, for the sake of the argument, the mailing address of Nishijima may be considered as a machine readable code, the mail sorting system of Nishijima is not designed to replace the mailing address. Rather, the system of Nishijima is designed to convert the mailing address into a barcode and to print the barcode on a blank area of the mail item, in addition to the mailing address. Thus, the mailing address and the barcode co-exist, which appears to teach away from the present invention as claimed.

In addition, there is no disclosure or suggestion within Torchalski and Nishijima to combine with each other. Here Torchalski is related to scan a label into a computer as a template for future editing and printing a label having a similar layout of the original scanning label. Nishijima's design is to print a barcode represent a mailing address, in addition to the mailing address, for sorting purposes. Since each mailing address is unique and there is no need to store the mailing address and/or barcode associated with the mailing address for future use. Once the sorting operations are completed, the generated barcode for the mailing address is almost useless and there is no need to store it into a computer as a template. It is respectfully submitted that one with ordinary skill in the art, based on the teachings of Torchalski and Nishijima, to combine these two references because such a combination lacks reasonable expectation of success.

Furthermore, even if Torchalski and Nishijima were combined, such a combination still lacks the limitations set forth above. Therefore, for the reasons discussed above, it is respectfully submitted that claim 1 is patentable over Torchalski and Nishijima.

Similarly, independent claims 14 and 28-30 include limitations similar to those recited in claim 1. Thus, for the reasons similar to those discussed above, independent claims 14 and 28-30 are patentable over Torchalski and Nishijima.

Given that the rest of the claims depend from one of the above independent claims, at least for the reasons similar to those discussed above, it is respectfully submitted that the rest of the claims are patentable over Torchalski and Nishijima. Withdrawal of the rejections is respectfully requested.

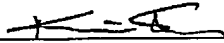
In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

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